

## **II. REMARKS**

Respectfully, and generally for the reasons set forth below, the objections and rejections and each ground therefor are traversed.

### **A. Paragraphs of Objections and/or Rejections**

#### **1. Paragraph 1 of the Office Action**

In paragraph 1 of the Office Action, the Examiner has issued a double patenting objection to claim 22 as a substantial duplicate of claim 21.

In response, the foregoing amendment has been submitted.

#### **2. Paragraph 2 of the Office Action**

In paragraph 2 of the Office Action, the Examiner has raised an issue of a possible public use or on sale bar.

In response, the evidence of record is insufficient to raise a no public use or on sale bar. The Examiner has cited no evidence more than one year prior to the filing of the patent application and no evidence of an invention by another prior to the date of the Applicant.

Further, the Examiner has requested a brief explanation of Inventor Chris Ewing's association with BlindGift and ZipSend, especially in connection with a partner Shari's Berrys.

Although the issue has not been properly raised, as a courtesy, it is believed that Chris Ewing made the invention and participated in starting a company (BlindGift) to implement his invention. BlindGift implemented the invention by using distribution partners, including Chris Ewing's other company Sherris Berry's, along with other order fulfillment companies. BlindGift changed its name to ZipSend and was subsequently subject to an asset purchase by Frog Magic, Inc. The Examiner is directed to the assignment records of the U.S. Patent and Trademark Office for a record of the assignment history of this patent application at Reel

012016, frame 0018, Frog Magic, Inc. acquired all right, title, and interest from the inventor named in the above-identified patent application: Christopher Ewing.

In sum, the patent application was filed on April 19, 1999, the PTO has shown no evidence of a public use or offer of sale more than one year before the filing date, nor prior invention by another, and the patent application owner has no knowledge of any such a public use, on sale bar either, or prior invention.

### **3. Paragraph 3 of the Office Action**

In paragraph 3, the Examiner has rejected claims 1-2, 4, 10-12, 19, 28-33 pursuant to 35 U.S.C. Sec. 102. The Examiner contends that these claims anticipated by Van Name.

In response, the rejection is respectfully traversed. Van Name summarizes features of separate and unrelated Internet sites and ideas that the Examiner has somehow melded together into a system of cooperating parts. Buy.com is not shown as connected to kencranes.com and / or Amazon.com, etc. Most certainly and Amazon.com is not connected to barnesandnobel.com either. These are separate web sites, though they are all listed in Van Name's article.

One of the separately listed and separately discussed web sites is Amazon.com's Gift Click system, which forms the basis of much of this rejection. However, Van Name does not teach or suggest anything about said non-pseudonymous name is not revealed to said party. In fact, Van Name explicitly teaches, clearly, and unmistakably teaches the exact opposite, namely that Amazon's system "**sends an email saying that you're sending a gift...**" (emphasis added). Amazon identifies the sender, which is completely contrary to the claimed invention. Thus, as to all listed claims, especially claims 1 and 19, there is no *prima face* anticipation.

As per claims 10 and 33, Van Name teaches two unrelated computer systems, Buy.com and Amazon.com, which the Examiner has interrelated as if it were a cooperating system. Van Name is referring to a different web sites, and this is not anticipation.

As per claims 11-12 and 28-29, Van Name teaches “greeting text” which the Examiner views as an “opportunity to reveal true identity....” An opportunity is not evidence of statutory anticipation.

As per other claims, the Examiner has gone beyond the teaching of Van Name. For example, as per claim 2, Van Name does not teach issuing an order. As per claims 30-33, the Examiner has exceeded the teaching of evidence as well.

Most important, however, is that Van Name is not statutory anticipation because it teaches the exact opposite to the claimed said non-pseudonymous name is not revealed to said party.

#### **4. Paragraph 4 of the Office Action**

In paragraph 4 of the Office Action, the Examiner has rejected claim 19 pursuant to 35 U.S.C. Sec. 102. The Examiner contends that the claim is anticipated by Webcertificate.

In response, the rejection is respectfully traversed. Like Van Name, Webcertificate Name teaches the exact opposite to the claimed said non-pseudonymous name is not revealed to said party. At line 22-23, Webcertificate states: “Webcertificate arrives as an **e-mail message notifying the recipient** that a gift has been sent and **the name of the sender**” (emphasis added). No *prima face* anticipation has been shown.

#### **5. Paragraph 5 of the Office Action**

In paragraph 5 (first) of the Office Action, the Examiner has rejected claim 3 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 3 is obvious in view of Van Nam and Barron.

In response, the rejection is respectfully traversed. Van Name is discussed above as not only failing to disclose said non-pseudonymous name is not revealed to said party, but indeed teaching the opposite. Barron does not teach this feature either, so there is an insufficient showing for a case of *prima face* obviousness.

Additionally, the Office Action provides no proper reason to combine Barron and Van Name. The Examiner's reason comes not from the cited art, but instead from hindsight. Also, Van Name cannot be combined with Barron to reach the claimed invention without contradicting and destroying the Van Name teaching that the Amazon system “**sends an email saying that you're sending a gift...**” (emphasis added).

More so, there is no indication anywhere in the cited art of even a recognition of the problem to be solved by the invention or the reason for the invention – anonymous or “blind” giving. With no recognition of the problem or reason for the invention in the cited art, a means for solving the unrecognized problem cannot be deemed obvious except by hindsight.

In sum, no *prima face* obviousness has been shown.

#### **6. Paragraphs 6, 5 (second, third, and fourth)-8 of the Office Action**

In paragraphs 6, 5 (second, third, and fourth)-8 of the Office Action, the Examiner has rejected claims 5-9, 13-18, 20-27 pursuant to 35 U.S.C. Sec. 103, based on contentions variously including Van Name, Webcertificate, Barron, Official Notice, contentions about automated bank teller machines.

In response, the rejection is respectfully traversed. Van Name and Webcertificate are discussed above as not only failing to disclose said non-pseudonymous name is not revealed to said party, but indeed teaching the opposite. Barron does not teach this feature either, so there is an insufficient showing for a case of *prima face* obviousness—nor does Official Notice and Examiner contentions about automated bank teller machines. Also, Van Name and Webcertificate cannot be combined with Barron or anything else to reach the

claimed invention without contradicting and destroying the Van Name teaching that the Amazon system “s ends an email saying that you’r s nding a gift...” (emphasis added) and the Webcertificate teaching “an e-mail message notifying the recipient that a gift has been sent and the name of the sender” (emphasis added). These are strictly contrary to the claimed method in which disclose said non-pseudonymous name is not revealed to said party.

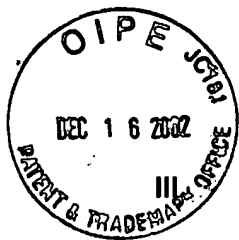
Accordingly, there is an insufficient showing for a case of *prima face* obviousness.

If the rejection is maintained, Applicant requires a reference or the Examiner’s affidavit or Declaration for every instance of Official Notice and contention about automated bank teller machine, at least to permit evaluation of whether there is a proper reason to combine the teachings in the manner proposed in the Office Action. This is especially true in view of contentions in the Office Action that exceed the scope of the teaching, misconstruing of Webcertificate and Van Name, the later not only regarding said non-pseudonymous name is not revealed to said party but also in the attempt to meld together completely unrelated computer systems.

Additionally, the Office Action provides no proper reason to combine the cited art. In every single instance, the purported reason for the combination comes not from the cited art, but instead from hindsight.

More so, there is no indication anywhere in the cited art of even a recognition of the problem to be solved by the invention or the reason for the invention – anonymous or “blind” giving. With no recognition of the problem or reason for the invention in the cited art, a means for solving the unrecognized problem cannot be deemed obvious except by hindsight.

In sum, no *prima face* obviousness has been shown.



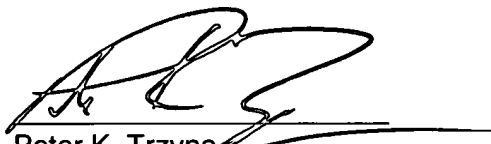
### Conclusion

The Examiner has graciously provided numerous ways to communicate regarding the instant case, and the Applicant and undersigned are most appreciative. The Examiner is invited to contact the undersigned at the telephone number set out below if it can in any way expedite or facilitate issuance of a patent on the application.

The application is believed to be in condition for allowance, and favorable action is respectfully requested. Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

Date: December 11, 2002

  
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